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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/414,710 10/08/99 FABER

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EXAMINER

TM02/1022

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ART UNIT

PAPER NUMBER

2163

DATE MAILED:

10/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/414,710

Applicant(s)
Faber et al.

Examiner
Susanna M. Díaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 2, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44-46, 48-51, 53-68, 70-88, 90-92, 97, and 104-108 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44-46, 48-51, 53-68, 70-88, 90-92, 97, and 104-108 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 20,21
- 18) ☐ Interview Summary (PTO-413) Paper No(s): _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

Continued Prosecution Application

1. The request filed on October 2, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) is acceptable and a CPA has been established. An action on the CPA follows.

Claims 44-46, 48-51, 53-68, 70-88, 90-92, 97, and 104-108 are currently pending.

No amendments or arguments have been submitted; therefore, the Examiner maintains the pending objections and rejections, which are reproduced herein.

2. The Examiner cannot find the replacement Abstract; therefore, the corresponding objection is maintained.

The Examiner cannot find the Terminal Disclaimer; therefore, the Double Patenting rejection is maintained.

The previous 35 USC 102 rejection over ExpertCity.com is withdrawn.

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Specification

3. The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(1). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 107 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

It is not clear what it meant by “information providing selecting” (lines 3-4). For examination purposes, this phrase will be interpreted as “information provider selecting.”

None of the phrases preceded by “the” have antecedent basis. For examination purposes, it will be assumed that claim 107 is dependent from claim 106.

Appropriate correction is required.

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Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 44-46, 48-51, 53-68, 70-88, 90-92, 97, and 104-108 are rejected under 35

U.S.C. 103(a) as being unpatentable over Lauffer (U.S. Patent No. 6,223,165 B1).

As discussed in paper no. 15, claims 44-46, 48-51, 53-68, 70-88, 90-92, 97, and 104 were rejected under 35 U.S.C. 102(e) as being “anticipated by copending Application No. 09/488,130 which has a common assignee with the instant application.” This application has evolved into Patent No. 6,223,165 B1. The Examiner continues to assert that the disclosure of Lauffer (Application No. 09/488,130, now Patent No. 6,223,165 B1) clearly anticipated all of the claim limitations prior to the most recent amendment. Furthermore, the Applicant only argues that Lauffer does not anticipate the “currently pending” claims (page 17 of Applicant’s amendment); therefore, the Examiner will only comment on the recently amended limitations since it has been agreed that all of the original limitations are indeed clearly anticipated by Lauffer, as discussed in paper no. 15.

Independent claims 44, 63, and 80 have been amended to recite “providing a list of information providers to a user prior to the user submitting a question, the list including an

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indication of whether an information provider is currently available at a time the user is viewing the list, and a price for each information provider. Claim 1 of Lauffer anticipates this limitation.

Independent claims 44, 63, and 80 have also been amended to recite “in response to a prepaid user account falling below a predetermined threshold, interrupting the connection and requesting the user add to the account.” While Lauffer does not explicitly disclose this limitation, he does discuss the use of credit card, cyber money, phone, or media accounts to make payment (col. 8, lines 27-29, 41). It is old and common knowledge to refuse service to someone if that person does not have the means to pay for such a service. For example, if one’s credit card is denied, service will be refused. If there is insufficient balance on a cyber money account (i.e., a prepaid user account), service is typically denied. Again, a phone call cannot be completed if the phone card used to make the call is lacking funds. Furthermore, a phone call may be cut off in mid-conversation if one’s funds run out. This is even analogous to the common scene in movies where the operator cuts in on an important call to announce, “Please deposit one dime.” These practices protect the respective service providers from not getting paid after providing a service. Consequently, it would have been obvious to one of ordinary skill in the art at the time of Applicant’s invention to interrupt a connection and request that the user of Lauffer’s system add money to his/her account in response to the prepaid user account falling below a predetermined threshold in order to ensure that information providers will adequately and timely be paid for services rendered.

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Regarding claims 105-108, Lauffer discloses a method of connecting two parties in real time, the method comprising:

[Claims 105, 106, 108] providing a list of information providers to a user prior to the user submitting a question, the list including an indication of whether an information provider is currently available at a time the user is viewing the list, and a price for each information provider (Claim 1);

in response to a user selecting an information provider from the list, establishing a real time voice communication connection between the information provider and the user (Claim 1).

As per claims 105 and 106, Lauffer fails to explicitly state that the current availability status of an information provider is updated via a telephone or a computer network connection in response to a direction received either via a telephone or a computer network connection; however, the Examiner asserts that Lauffer's system would be very inefficient if it did not continue to update an information provider's status when any status changes occur. Furthermore, Lauffer's system keeps track of when an information provider is providing his/her services for billing purposes; therefore, Lauffer's system is perfectly capable of tracking any changes in each information provider's status. Additionally, if Lauffer's system did not update availability status of the information providers, many users would become frustrated with having to guess if an information provider is available or not. Consequently, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to update a current availability status of an information provider via a telephone or a computer network

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connection in response to a direction received either via a telephone or a computer network connection as part of Lauffer's invention in order to promote efficient and accurate matching of information providers to users in order to encourage repeat business from satisfied customers.

As per claim 107, Lauffer does not explicitly explain how the information providers update their statuses; however, this update is likely performed, as discussed above. Furthermore, when Lauffer's information providers are ready to use the system, they log onto it. It is old and well-known in the art to log into and out of an Internet web page by clicking on a hyperlink; therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to allow Lauffer's information providers to update their current availability statuses by selecting an available hyperlink provided on a web page in order to enable quick and direct communications with the central controller so that updates are made as accurately, conveniently, and efficiently as possible.

As per claim 108, it is very old and well-known in the art to send a message to someone when a connection cannot be completed. For example, telephone calls that cannot be completed are often followed by the message, "All circuits are busy. Please try your call again later." Also, when the Internet cannot take a computer user to a desired web site, a message stating this is typically displayed to the computer user (e.g., "The server is not responding. Please try again later."). These types of messages make one aware that there is a problem and that a connection attempt would likely be more successful if attempted later. Analogously, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to provide a

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message to Lauffer's information provider indicating the failure to connect with the user in response to a failure to connect with the user in order to make the information provider aware of what is going on so that he/she may pursue more profitable activities (instead of wasting his/her time waiting for a connection which will never be completed). Naturally, since the information provider was never connected to the user, he/she would be available again. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to then automatically update the current availability status of Lauffer's information provider to indicate that the information provider is currently available so that the information provider can quickly try to attract more business in order to make money.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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9. Claims 44-46, 48-51, 53-68, 70-88, 90-92, 97, and 104-108 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of U.S. Patent No. 6,223,165 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons discussed in the art rejection above.

Conclusion

10. This is a CPA. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Díaz whose telephone number is (703) 305-1337. The examiner can normally be reached Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (703) 305-9643. The fax numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for Official communications, (703) 746-7240 for Non-Official communications, and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900 or to the Customer Service Office on (703) 306-5631.

SMD

October 20, 2001

TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
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